

REMARKS

This amendment is offered in reply to the office action of November 14, 2003.

Applicant has cancelled claims 1-8 without prejudice to advance prosecution of this application. Applicant reserves the right to further prosecute cancelled claims 1-8 at a later date by way of divisional application or other appropriate means.

The pending claims are believed to overcome the rejections set forth in the office action of November 14, 2003.

For example, in paragraph 2 of the office action, claims 19 and 22-23 are rejected under 35 USC 102(a) in view of admitted prior art (AAPA) as found on page 1 and on page 12, fourth full paragraph to page 14, fourth full paragraph.

Claim 19 now recites first and second gasket layers having features not disclosed in the AAPA. The same is true with respect to claims 22 and 23.

Reconsideration of the Section 102(a) rejection of pending claims 19, 22, and 23 is requested.

In paragraph 4 of the office action, claims 1, 3-9, 11-19, and 22-23 are rejected under 35 USC 103(a) in view of admitted prior art (AAPA) as found on page 12, fourth full paragraph to page 14, fourth full paragraph with reference to Figure 2 further taken with DE 884936 ('936).

The AAPA is deficient in disclosing or suggesting the features of these claims. Moreover, Applicant disagrees firstly with the proposed combination of the '936 reference with the AAPA. In particular, the '936 reference involves a process for the manufacture of furniture fitting members. The manufacture of

USSN 09/892 052

furniture fitting members is not believed to be even remotely pertinent to manufacture of Applicant's gaskets and not properly combinable therewith as proposed by the examiner. The proposed combination of the '936 reference with the AAPA appears to constitute a prohibited hindsight analysis of Applicant's claims.

Secondly, the '936 reference does not make up for the deficiencies of the AAPA. In particular, the '936 reference involves a process for the manufacture of furniture fitting members wherein the fitting members are punched out of a metal sheet by means of punching tools (e.g. f and g) having corners to their cutting edges as can be seen from Figure 1 of the reference and from the enclosed attachment A showing the '936 reference cutting tool.

Further, the outer contour line cut by the tool (e.g. m) for cutting out a contour line according to the '936 reference does not dip into the cutting areas (first cutting area and second cutting area) cut by the punching tools in the preceding punching stations, but only meet the second cutting area at a corner thereof (see the attachment A of the '936 reference cutting tool).

USSN 09/892 052

The '936 reference teaches only to use punching tools having corners to their cutting edges and to use a tool for cutting an outer contour line which does not dip into the free-cutting area, but only meets the free-cutting area at a corner thereof. The '936 reference as well as the AAPA teach away from the subject matter of Applicant's pending claims 1, 3-9, and 11-19.

With respect to claims 19 and 22-23, these claims are believed patentable over the AAPA taken with the '936 reference for the reasons set forth above and also since the '936 reference involves manufacture of furniture fitting members, which are not pertinent to and utterly unrelated to Applicant's claimed gasket structure.

Reconsideration of the Section 103(a) rejection of claims 1, 3-9, 11-19, 22-23 is requested.

In paragraph 5 of the office action, claim 18 is rejected under 35 USC 103(a) in view of admitted prior art (AAPA) as found on page 12, fourth full paragraph to page 14, fourth full paragraph taken with the '936 reference and an additional reference selected from either US 4 862 574; US 3 998 300; or US 3 822 461.

Applicant believes the rejection of claim 18 is incorrect. The proposed combination of the AAPA and the '936 reference is not believed correct and not to suggest Applicant's invention as set forth in detail above. Moreover, the '574 patent involves a panty protector which is utterly unrelated to Applicant's claimed process for making a gasket. The '300 patent involves a drum brake shoe which also is utterly unrelated to Applicant's claimed process for making a gasket. The '461 patent involves a disposable tissue lancet which also is utterly unrelated to

USSN 09/892 052

Applicant's claimed process for making a gasket. The proposed combination of the '936 reference together with the '574 patent, the '300 patent, or the '461 patent with the AAPA is not supported by the references themselves and clearly constitutes a prohibited hindsight analysis of claim 18.

Reconsideration of the Section 103(a) rejection of claim 18 is requested.

Applicant believes the pending claims are in condition for allowance, and action to that end is requested.

Applicant has added new claims 24 and 25.

Favorable action on the pending claims is requested.

The Commissioner is authorized to charge any fee for new claims 24-25 to my deposit account No. 20-1124.

Respectfully submitted,



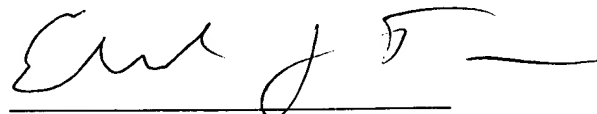
Edward J. Timmer
Reg. No. 27 402

Enclosure:

Telephone: 269-629-9136

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service under 37 CFR 1.8 as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 15, 2004.



Edward J. Timmer